

REMARKS

Claims 2-5, 8-9, 12, and 14-21 are currently pending in this application. No amendments have been made, and therefore, no new matter has been added.

Request for Telephone Interview Prior to Formal Action on Amendment

Applicants respectfully request a brief telephone interview prior to formal action on this response. An "Applicant Initiated Interview Request Form" accompanies this response. Please contact Applicants' undersigned representative to schedule the interview.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 2-3, 8-9, and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication Number 2002/0019984 A1 ("Rakib"). Applicants respectfully request that the rejection of claims 2-3, 8-9, and 20 be withdrawn for at least the following reasons.

The rejection of claims 2-3, 8-9, and 20 as recited in the Office Action dated February 13, 2007 is not a proper 35 U.S.C. § 102(b) rejection. 35 U.S.C. 102(b) recites:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

In addition, a claim is anticipated under 35 U.S.C. § 102(b) only if each and every element as set forth in the claim is found expressly or is inherently described in a single prior art reference, and the elements must be arranged as required by the claim. M.P.E.P. § 2131.

Rakib at least does not teach a memory of a first amusement device storing a plurality of video games playable on the first amusement device, as required by independent claim 8. Rakib teaches a specialized remote control PDA for navigating a headend file server that is capable of interacting with games resident on a server at the headend. (See ¶ 84). The Examiner fails to point to an explicit or implicit disclosure within the four corners of Rakib regarding storing a

plurality of games in the memory of the remote control PDA. In addition, we have carefully reviewed the reference have not found any disclosure remotely teaching or suggesting that the remote control PDA of Rakib include a memory storing a plurality of video games playable on the remote control PDA.

Although the Examiner states in ¶ 4 of the Office Action that storing the games on the memory of the remote control PDA rather than the headend server is a “matter of design choice” and that PDAs are “well known in the art as being capable of storing and playing video games”, the Examiner’s arguments are not proper for a 35 U.S.C. § 102(b) rejection. M.P.E.P. § 2144.03 allows an Examiner to rely on common knowledge in the art or “well known” prior art. M.P.E.P. § 2144.04 allows an Examiner to consider factors, such as rearrangement of parts, in determining patentability. However, both of these sections of the M.P.E.P. are treated under § 2144 as sources of rationale for supporting an obviousness rejection under 35 U.S.C. § 103, not an anticipation rejection under 35 U.S.C. § 102(b). By undertaking the above-listed arguments, the Examiner is impermissibly modifying Rakib to effect a 35 U.S.C. § 102(b) rejection.

Additionally, the Examiner’s rationales for rejecting claim 8, even if properly within the purview of 35 U.S.C. § 102, are nevertheless improper under the standards required by the M.P.E.P. The mere fact that one could rearrange the parts of the reference to meet the claim terms cannot itself support a finding of obviousness; in the prior art there must be a motivation or reason for one in the art, without the benefit of applicant’s disclosure, to change the reference device. M.P.E.P. § 2144.04.

To require the plurality of games to be stored on the remote control PDA of Rakib teaches away from the reference itself. The main thrust of the invention disclosed by Rakib is to provide a specialized PDA for remotely communicating with a gateway to act as a remote control to analog and digital equipment at a customer premises. Rakib is disclosing what amounts essentially to a “dumb” terminal for navigating a headend file server. In fact, one embodiment of the remote control in Rakib does not include a display, which clearly teaches away from storing a plurality of games for play in the memory of the remote control. (See ¶ 51, 53). A video game cannot be played on a PDA without some form of display.

Further, an Examiner should not rely on common knowledge in the art without documentary evidence unless the facts are capable of instant and unquestionable demonstration as being well-known. Additionally, circumstances for taking “official notice” should be rare when, as here, an application is under final rejection. M.P.E.P. § 2144.03.

The Examiner has provided no evidence to support the argument that it was well-known in the art at the time the present application that PDA devices were capable of storing and playing a plurality of video games. Under the provisions of M.P.E.P. § 2144.03, we request that the Examiner provide the explicit basis for this assertion. Rakib discusses some common features of PDAs but makes no suggestion that it was well-known to include a plurality of games on such devices. The other references cited by the Examiner, U.S. Patent Numbers 5,481,509 (“Knowles”) and 5,848,398 (“Martin”), are directed to computer jukeboxes and have no relevance to PDA functionality.

It is therefore respectfully submitted that independent claim 8 is not anticipated by Rakib because Rakib does not disclose or suggest each and every element of claim 8. Claims 2-3, 9, and 20 depend from claim 8. Accordingly, Applicants respectfully request that the rejection of independent claim 8 and dependent claims 2-3, 9, and 20 under 35 U.S.C. § 102(b) be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claims 4-5, 12, 14-19, and 21 have been rejected under 35 U.S.C. § 103 as being unpatentable over Rakib in view of Knowles. In paragraph 11, the Examiner introduces Knowles as a currency operated jukebox, but in the next sentence states that one “would be motivated to combine the currency operation method of Martin et al. with” Rakib. The Examiner then continues to discuss Knowles. Applicants believe this to be an error and that the reference to Martin is intended to be a reference to Knowles. If this is incorrect, Applicants respectfully request withdrawal of the current rejection in order to clarify the Examiner’s arguments.

Proceeding under the assumption that the rejection under 35 U.S.C. § 103 is based solely on a combination of Rakib and Knowles, Applicants respectfully request that the rejection of claims 4-5, 12, 14-19, and 21 be withdrawn for at least the following reasons.

Independent claims 8, (from which claims 4-5 depend), 12 (from which claims 14-19 depend), and 21 each require that the memory of the first amusement device store a plurality of video games playable on the first amusement device. As discussed above regarding the rejection under 35 U.S.C. § 102(b), the Examiner has failed to demonstrate that this claimed feature is disclosed expressly or inherently within Rakib. In order to establish obviousness, the references when combined must teach or suggest all of the claim limitations. M.P.E.P. § 2143.

Knowles is directed to a jukebox including a plurality of hard disc drives for storing digital audio and video data. There is no teaching or suggestion in Knowles of storing a plurality of games in the memory of a PDA. Therefore, Knowles cannot compensate for the deficiencies of Rakib as a prior art reference. Claims 4-5, 12, 14-19, and 21 cannot be obvious under 35 U.S.C. § 103 in view of the combination of Rakib and Knowles because the references together do not teach or suggest the claim limitation of storing a plurality of video games on the memory of the first amusement device.

Additionally, there is no motivation to combine Rakib and Knowles to achieve the suggested modifications. As the Examiner points out, Rakib already teaches using the specialized PDA for ordering video-on-demand programs. With typical video-on-demand, billing is often accomplished by inclusion of charges in a monthly cable bill if using a home TV set, or inclusion of the charges in a room bill if using a hotel TV set. The PDA could also be used to perform an immediate credit transaction over the server by entering credit card information directly.

Knowles teaches a currency operated feature, such as a money validator, on a jukebox machine. (See col. 3, line 44 – col. 4, line 6). Adding a local currency operated feature to the system of Rakib, which already has a built-in payment method, is superfluous. Further, it teaches away from the invention of Rakib. Cable/room bills and headend server credit transactions allow for streamlining of collection as well as tracking and billing. (See ¶ 110). A local money validator requires an employee to extract the deposited funds from each local unit.

Such local units also typically are not capable of handling large sums of money, which video-on-demand occasionally requires. Using a the server to acquire billing or credit card information reduces both cost and time spent retrieving funds.

It is therefore respectfully submitted that independent claims 12 and 21 are not obvious in view of the combination of Rakib and Knowles because there is no motivation to combine the references and the references together do not disclose or suggest each and every element of claims 12 and 21. Claims 4-5 depend from claim 8 (discussed above). Claims 14-19 depend from claim 12. Accordingly, Applicants respectfully request that the rejection of independent claims 12 and 21 and dependent claims 4-5 and 14-19 under 35 U.S.C. § 103 be withdrawn.

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CONCLUSION

In view of the foregoing Remarks, it is respectfully submitted that the present application including claims 2-5, 8-9, 12, and 14-21, is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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